

SUMMARY OF CLAIM AMENDMENTS UNDER 37 CFR §1.173(c)

The amendments made to claim 1 herein find support in the '282 Patent at 2:54-62, Figure 1, and 4:12-5:21. The amendments made to claim 9 deletes superfluous matter and finds support in the claim as originally filed. The amendments made to claim 10 represent changes only as to form and not substance. The amendments made to claim 11 simply rearrange elements. The amendments made to claim 16 herein find support in the '282 Patent at 2:54-62, Figure 1, and 4:12-5:21.

Status of Claims

In consideration of the Examiner, below is the current status of the claims of the present re-issue application:

1	Original patent claim amended September 1996;
2	Original patent claim canceled herein;
3-8	Original patent claims;
9-11	Original patent claims, amended herein;
12-15	Original patent claims;
16	New September 1996, amended herein;
17-20	New September 1996, amended September 1997; and
21-22	New September 1996, canceled herein.

REMARKS

By this amendment, claims 1, 9-11, and 16 have been amended, and claims 2, 21, and 22 have been canceled.

Claim 1 has been amended to include the limitation of claim 2, namely, that the TV module includes a video recorder. Claim 1 also now makes it clear that the various components are all enclosed in the same housing. Claim 2 was rejected under 35 U.S.C. §103(a) over Inomata in view of Furrey ('653). While conceding that Inomata does not teach or suggest components contained within a VCR unit, the Examiner argues that it would have been obvious to modify Inomata to utilize the VCR as a TV module "at least for the desirable benefit of reducing the number of components, necessary to operate the system."

The Examiner's argument is flawed on several grounds. First, there is no proof whatsoever that "to utilize the VCR as the TV module" would reduce the number of components necessary to operate the system. Indeed, an important point of Inomata et al. is simplification, and to achieve this purpose,

Inomata integrates its connection unit 5 directly into an AV center 1 providing a rack for whatever components the user may wish to integrate. Making VCR 17 the “TV module” or connection unit 5 would either result in redundant electronic circuitry or, worse, if VCR 17 were not provided *by a user*, the system of Inomata would not function. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

There is also no teaching or suggestion from the prior art in support of the Examiner’s proposed combination. The point and purpose of Inomata et al., as exemplified by the title, is to provide an “audio-visual system having integrated components for simpler operation.” Everything is integrated into the AV system, including an AV center 1, power amplifier 3, connection unit 5, speaker system 7, rack 11 and remote control optical signal radiator 9. (‘317 patent 2:34-39). It would defeat the overall purpose of Inomata et al. to make any one component “special” as claimed by Applicant in this case. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Although independent claim 11 was also rejected under 35 U.S.C. §102(e) over Inomata, Applicant believes the Examiner has overlooked certain important language in the claim. In particular, it must be noted that, in accordance with claim 11, test control codes are transmitted to the associated unit *each time* the TV module is energized. The operation is then analyzed without operator intervention. Inomata et al. neither teach nor suggest automated control code determination during power up. Rather, according to the ‘317 patent, a “register” switch of the AV center 1 must be turned on (step 401). (‘317 patent 3:42+; Figure 5). Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Systems*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure “that ‘almost’ meets that standard does not ‘anticipate’.” *Connell v. Sears, Roebuck Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Given that Inomata et al. do not teach or suggest each and every element of this claim, *prima facie* anticipation has

not been established.

Claim 16 has been amended to include the limitation of claim 22, which has been canceled. Claim 21 has been canceled as well. Considering claims 10, 15 and 22, the Examiner takes official notice that at the time the invention was made, "audio or acoustic sensors were well known in the art." That something is "available" is not a sound basis for rejection. The Examiner's argument is that a modification of Inomata would be obvious "at least for the purpose of providing an additional test of the status of the instant AV component." First, there is no proof or evidence that Inomata et al. were interested in any kind of additional "test." There is no teaching or suggestion, other than that disclosed by Applicant, in support of this combination, thereby relegating the rejection to one of hindsight. Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011,1017,154 USPQ 173, 177 (CCPA 1967), cert. denied, 389U.S. 1057 (1968). Clearly *prima facie* obviousness has not been established.

Based upon the foregoing amendments and comments, Applicant believes this application is in condition for allowance. Questions regarding this application may be directed to the undersigned attorney by telephone, facsimile or electronic mail.

Respectfully submitted,

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